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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/693,205 | 10/20/2000 | Thomas J. Hudson | 2825.1021-003 | 7268 |

21005 7590 04/25/2003

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EXAMINER

KAM, CHIH MIN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1653

23

DATE MAILED: 04/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/693,205

Applicant(s)

HUDSON ET AL.

Examiner

Chih-Min Kam

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 4/8/03. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1,9-12 and 23.

Claim(s) objected to: _____.

Claim(s) rejected: 6 and 8.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The amendment to the claims does not resolve the current issues under 35 USC 112, first paragraph. It also raises new issues regarding the fragment of SEQ ID NO:7 comprising nucleotide positions 6393-6395, and a nucleic acid molecule that hybridizes under high stringency conditions to a nucleotide sequence comprising nucleotide positions 6393-6395, which require further search. In the amendment of April 8, 2003, claims 2-4 and 7 have been cancelled, and claims 6 and 8 have been amended. Applicants' response has been fully considered, however, claims 6 and 8 are rejected under 35 USC 112, first paragraph.

If applicants' amendment were entered, it would have the following response:

1. Claims 6 and 8 are rejected under 35 USC 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 6 and 8 are directed to a fragment of SEQ ID NO:7 comprising nucleotide positions 6593-6595 of SEQ ID NO:7 and is at least 15 nucleotides; or a nucleic acid which hybridizes under stringency conditions to a nucleotide sequence comprising nucleotide positions 6593-6595 of SEQ ID NO:7 and is at least 10 flanking nucleotides of SEQ ID NO:7. However, the specification does not identify any fragment of SEQ ID NO:7 containing nucleotide positions 6593-6595 of SEQ ID NO:7 and at least 10 or 15 nucleotides. Without guidance on the identities of the fragments of SEQ ID NO:7 containing nucleotide positions 6593-6595, and the correlation of structure to function/activity, one skilled in the art would not know how to use the fragments. The lack of representative examples and teachings for the fragments of SEQ ID NO:7 containing nucleotide positions 6593-6595 as encompassed by the claims, applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise terms that a skilled artisan would not recognize applicants were in possession of the claimed invention. In response, applicants indicate the specification discloses the nucleotide sequence of SEQ ID NO:7, and state the invention includes fragments of SEQ ID NO:7 (page 3, lines 8-12), and nucleic acid molecules which hybridize under stringency conditions to a nucleotide sequence of SEQ ID NO:7 (page 17, line 11-page 18, line 11). The argument is not found persuasive because the specification does not disclose the identities of any fragments containing nucleotide positions 6593-6595 of SEQ ID NO:7 as indicated above.

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (page 42, lines 22-28). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. In response, applicants indicate the embedded hyperlinks have been disabled in the prior amendment (page 3 of the response), however, the amended section still contains part of the code, please delete the code completely.

Continuation of 3. Applicant's reply has overcome the following rejection(s): If entered, the rejection of claim 6 under USC 102(a).

Continuation of 5. does NOT place the application in condition for allowance because: The amendment to the claims does not resolve current issue under 35 USC 112, first paragraph.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*
April 23, 2003

Christopher S. F. Low
CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
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